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|   |             |                      |                                |                  |
|---|-------------|----------------------|--------------------------------|------------------|
| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.            | CONFIRMATION NO. |
| 10/510,675  | 10/06/2004  | George R. Pettit     | 12504.528                      | 4965             |
| 7590<br>Susan Stone Rosenfield<br>Craig Fennemore<br>3003 North Central Avenue<br>Suite 2600<br>Phoenix, AZ 85012 |             |                      | EXAMINER<br>KEYS, ROSALYND ANN |                  |
|   |             |                      | ART UNIT                       | PAPER NUMBER     |
|   |             |                      | 1621                           |                  |
| SHORTENED STATUTORY PERIOD OF RESPONSE  |             | MAIL DATE            | DELIVERY MODE                  |                  |
| 3 MONTHS  |             | 02/27/2007           | PAPER                          |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/510,675

**Applicant(s)**

PETTIT ET AL.

**Examiner**

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 11-23 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 14 and 18-23 is/are allowed.
- 6) ☒ Claim(s) 1-3, 11-13, and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Status of Claims***

1. Claims 1-4 and 11-23 are pending.  
Claims 4, 14, 18-23 are allowed.  
Claims 1-3, 11-13, and 15-17 are rejected.  
Claims 5-10 are cancelled.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gracza et al. (Journal of Chromatography, April 1984, Vol. 287, No. 2, pages 462-465), for the reasons given in the previous office action, mailed May 16, 2006.
5. Claims 3, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryu et al. (Arch. Pharm. Res., January 1994, Vol. 17, No. 1, pages 42-44), for the reasons given in the previous office action, mailed May 16, 2006.
6. Claims 1-3, 11-13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soby et al. (US 2003/0118617 A1), for the reasons given in the previous office action, mailed May 16, 2006.

***Allowable Subject Matter***

7. Claims 4, 14 and 18-23 are allowed.

Response to Arguments

**Claim Rejections - 35 USC § 102**

8. Applicant's arguments, see page 23, lines 9-11, filed November 20, 2006, with respect to the rejection of claims 2, 7 and 12 under 35 U.S.C. 102(b) as being anticipated by Spath et al. (Synthesis of pterostilbene. Ber. February 1941, Vol. 74B, pages 189-192 have been fully considered and are persuasive. The rejection of claims 2, 7 and 12 has been withdrawn.

9. Applicant's arguments, see page 24, lines 15-18, filed November 20, 2006, with respect to Claims 1 and 2 under 35 U.S.C. 102(b) as being anticipated by Takaoka (Proceedings of the Imperial Academy (Tokyo), October 1940, Vol. 16, pages 405-407, have been fully considered and are persuasive. The rejection of claims 1 and 2 has been withdrawn.

10. Applicant's arguments, see page 25, beginning at line 11, filed November 20, 2006, with respect to Claims 1, 11 and 15 under 35 U.S.C. 102(a) as being anticipated by Ghai et al. (US 2002/0028852 A1), have been fully considered and are persuasive. The rejection of claims 1, 11 and 15 has been withdrawn.

11. Applicant's arguments, see the paragraph bridging pages 28 and 29, filed November 20, 2006, with respect to Claims 1, 11 and 15 under 35 U.S.C. 103(a) as being unpatentable over Ghai et al. (US 2002/0028852 A1), have been fully considered and are persuasive. The rejection of claims 1, 11 and 15 has been withdrawn.

12. The rejection of Claims 1, 2, 11 and 12 under 35 U.S.C. 103(a) as being unpatentable over Takaoka (Proceedings of the Imperial Academy (Tokyo), October 1940, Vol. 16, pages 405-407) is withdrawn, since there is no disclosure of a pharmaceutical use in this reference and there is no evidence that these compounds were known to have pharmaceutical use in 1940.

**Rejection of claims 3 and 13 under 35 U.S.C. 103(a) as being unpatentable over Gracza et al. (Journal of Chromatography, April 1984, Vol. 287, No. 2, pages 462-465)**

13. Applicant's arguments filed November 20, 2006 have been fully considered but they are not persuasive. The Applicants arguments with regard to the cytotoxicity of the claimed cis compounds with

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respect to the prior art trans compounds are not sufficient to overcome the prima facie case of obviousness because a compound which is isomeric with compounds of prior art, is not patentable where the compound is not shown to possess new and unexpected utilities. *In re Norris*, 37 C.C.P.A. (Patents) 876, 179 F.2d 970, 84 USPQ 458. The Applicants have not shown that their cis compounds possess a new and unexpected utility.

Thus, this rejection is maintained.

Rejection of claims 3, 13 and 17 under 35 U.S.C. 103(a) as being unpatentable over Ryu et al. (Arch. Pharm. Res., January 1994, Vol. 17, No. 1, pages 42-44)

14. Applicant's arguments filed November 20, 2006 have been fully considered but they are not persuasive for the same reasons they were not persuasive with regard to the Gracza et al. reference.

Further, structural relationships may provide the requisite motivation or suggestion to modify known compounds to obtain new compounds. For example, a prior art compound may suggest its homologs because homologs often have similar properties and therefore chemists of ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties. Similarly, a known compound may suggest its analogs or isomers, either geometric isomers (cis v. trans) or position isomers ( e.g. , ortho v. para).

This rejection is therefore maintained.

Rejection of claims 1-3, 11-13 and 15-17 under 35 U.S.C. 103(a) as being unpatentable over Soby et al. (US 2003/0118617 A1)

15. Applicant's arguments filed November 20, 2006 have been fully considered but they are not persuasive.

The Applicants argue that Soby fails to provide enablement for any single compound disclosed therein a reference need not disclose what is well known in the art.

*In re MYERS*, 161 USPQ 668 (CCPA 1969). Methods for making resveratrol and its derivatives were well known at the time of the Soby reference (see for example column 4, lines 20-44 of US 6,197,834 B1).

Further, when the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable/enabling. Once such a reference is

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found, the burden is on applicant to provide facts rebutting the presumption of operability. In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980).

The Applicants further argue that the one of skill in the art for methods of treating cancer will not find motivation in the teaching of Soby. The Examiner disagrees. Soby et al. clearly teach that resveratrol and its analogues are known as carcinogenesis inhibiting agents (see paragraph 0007).

This rejection is maintained.

### ***Conclusion***

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

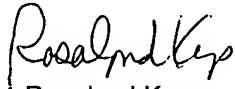
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M, W & F 5:30-7:30 am & 1-5 pm; T & Th 5:30 am-4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Rosalyn Keys  
Primary Examiner  
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February 19, 2007